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HEWLETT-PACKARD COMPANY
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EXAMINER

HANNE, SARA M

ART UNIT PAPER NUMBER

2179

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,409

Applicant(s)

SIMPSON ET AL.

Examiner

Sara M Hanne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment received on May 20, 2004. Amended Claims 1, 12 and 16 with original Claims 2-11, 13-15 and newly presented Claim 17 are pending in the application.

Claim Rejections - 35 USC § 102

2. Claims 1-5, 7-9, 12 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by McKnight et al., US Patent 6670974.

As in Claim 1, McKnight et al. teaches a system that provides a history list of imaging compositions ("a usage history is communicated in a chronological order", Column 4, lines 43-44) where each imaging composition includes links to imaging data to be services as a single unit (Column 9, lines 61-67) and where the imaging data associated with a user through a user profile (see also Column 7, line 32 et seq.) with a composition store used for storing the list and compositions and maintaining the list ("saved usage contexts may be stored and selectively accessed on a user's information handling system", Column 3, lines 3-5) and a personal imaging repository that provides, for a composition store, an exchange infrastructure between the imaging data associated with the user and available web service ("store web browsing contexts for later user even after the web browsing session has terminated.", Column 3, lines 1-3 also printing process described Column 7 is a web service).

As in Claim 2, McKnight et al. teaches associating a user profile with the image (view function 512 and properties function 810, Columns 7-8).

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As in Claim 3, McKnight et al. teaches each imaging data in the composition to be indicated by a Uniform Resource Locator ("the number of links contained in the item of usage 1216 as well as to what those links pertain, such as a link to a file transfer protocol site 1218", Column 9, lines 64-67).

As in Claim 4, McKnight et al. teaches an imaging data store in the repository for storing the imaging data ("a default load control 158 may be utilized to set the default load, such as live or stored. ... a stored version contained on the user's system", Column 5, lines 16-20).

As in Claim 5, McKnight et al. teaches the imaging data to be stored in several file formats ("Adobe® Photoshop® 1024, sound file 1026, home page 1028 or any other application may be generated to correlate the relevant item of usage.", Column 8, lines 53-56).

As in Claim 7, McKnight et al. teaches a file format of at least pdf and jpeg (Adobe® Photoshop® supports image file types).

As in Claims 8 and 9, McKnight et al. teaches the composition store to receive and save new image compositions in the composition store and add them to the history list ("The method of generating a persistent usage context includes monitoring the navigation of a resource during a first navigation session to obtain navigation data and storing navigation data", Column 2, lines 58-62).

As in Claims 12 and 16-17, McKnight et al. teaches a method, system and computer program product with a usable medium and codes for receiving, on behalf of a user, a new image composition from a network service ("The method of generating a persistent usage context includes monitoring the navigation of a

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resource during a first navigation session to obtain navigation data and storing navigation data", Column 2, lines 58-62), the imaging composition including links to imaging data to be services as a single unit (Column 9, lines 61-67) and where the imaging data associated with a user through a user profile (see also Column 7, line 32 et seq.) and saving it in the composition store of a personal imaging repository associated with the user through the user profile (Column 3, lines 1-5 and Column 7, line 32 et seq.), adding the new imaging composition to a history list maintained by the composition store ("representations may be generated indicating an Adobe® Photoshop® image 1108, received 1110, and then stored on a drive 1112", Column 9, lines 37-39), and providing the list to the user associated with the repository in response to a request for the list (Figure 15, reference 1502, the History Button).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 10, 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKnight et al., US Patent 6670974.

McKnight et al. teaches a system and method for creating a history list of saved imaging compositions that is adapted as new sites are accessed or files opened as seen *supra*.

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In reference to Claim 6, McKnight et al. fails to teach a converter in the repository for converting the imaging data to any of the file imaging formats. However it is well known in the art for a browser to convert pages to an appropriate imaging format for that particular browser (See further US Patent 5903889, Figure 5d and Column 9, lines 1-6).

It would be obvious to one of ordinary skill in the art to have a converter in the image repository so that the images may be formatted different types for accessing ease. One would have been motivated to make such a combination because a way for accessing data types that the system is unfamiliar with would have been obtained.

In reference to Claims 10, 11 and 14, McKnight et al. fails to teach having a predefined maximum number of composition and deleting the oldest composition when the maximum has been met as recited in the claims, however this limitation is well known (See further US Patent 6049812, Column 2 lines 32-49).

It would be obvious to one of ordinary skill in the art to monitor the number of compositions in the history list and delete the oldest if a maximum has been met in order to have a limited list where the most recent information will be upheld and the oldest may be purged. One would have been motivated to make such a combination because a history list monitoring method that follows system and memory constraints in the most useful way would have been obtained.

In reference to Claim 13, McKnight et al. fails to teach requesting a connection to the composition store determining whether the connection is

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successful, returning an error if it is not, and if it is successful, sending the new composition to the store, however this limitation is well known (See further US Patent 6049812, Column 2 lines 32-49). Furthermore, In reference to Claim 15, McKnight et al. fails to teach requesting a connection to the composition store, determining whether the connection is successful, returning an error if it is not, and if it is successful, requesting the history list from the composition store however this limitation is well known (See further US Patent 6049812, Column 2 lines 32-49).

It would be obvious to one of ordinary skill in the art to return an error to the browser if the connection is not successfully made and continuing on with the user's request if the connection is successfully made. One would have been motivated to make such a combination because a history list monitoring method for indicating successful or non-successful connection status would have been obtained.

Response to Arguments

Applicant's arguments filed May 20, 2004 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The rejection stands as previously stated as seen *supra*. The amendments to the claims do not patentably distinguish them from the prior art

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and can be clearly seen as referenced above and with respect to the amendments as follows.

With respect to the argument that McKnight does not teach a history list of imaging compositions where each imaging composition includes links to imaging data to be services as a single unit and where the imaging data associated with a user through a user profile, the examiner disagrees. The rejection of Claim 1 as previously stated does show these limitations as well as the user profile (see also Column 7, line 32 et seq.)

With respect to the argument that McKnight does not teach a personal imaging repository that provides, for a composition store, an exchange infrastructure between the imaging data associated with the user and available web service, the examiner disagrees. This limitation is clearly taught by the reference as stated above through the rejection of Claim 1. Furthermore, the term "web service" is broad and can be interpreted to mean many different things (for example in McKnight printing described in Column 7 is a web service).

With respect to the argument that McKnight fails to teach receiving, on behalf of a user, a new imaging composition from a network service where the imaging composition has links to imaging data associated with the user through a user profile the examiner disagrees. See rejections of Claim 8 and 12 *supra*.

With respect to the argument that McKnight does not teach saving an imaging composition to a composition store of a personal imaging repository associated with the user through the user profile the examiner disagrees and points out the rejection of Claim 12 *supra*.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar history list creation methods and image formatting/conversions. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (703) 305-0703. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

BA HUYNH
PRIMARY EXAMINER